



Attorney Docket # 5016-2

GAU 6016  
OS CO #  
PATENT  
(5)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Yisroel LEFKOWITZ

Serial No.: 09/729,984

Filed: December 05, 2000

For: Method and Apparatus for Selling International  
Travel Tickets in Combination with Duty Free  
Goods

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Washington, D.C. 20231, on

January 26, 2001

(Date of Deposit)

Martin B. Pavane  
Name of applicant, Assignee or Registered Representative

Signature

January 26, 2001

Date of Signature

Assistant Commissioner for Patents  
Washington, DC 20231

PETITION TO MAKE SPECIAL

Pursuant to M.P.E.P. §708.02 (VIII), the applicant hereby Petitions to Make  
Special the above-captioned application on the basis that a pre-examination search was  
performed.

Summary of the Claimed Invention

The invention as claimed is a method and system of selling international travel  
tickets to consumers in conjunction with the sale of duty-free items, by offering one or the  
other for sale at a discount from otherwise-available prices, while providing the other at  
reduced prices, or even free. As fully described in the specification as filed, the inventor  
affords numerous advantages over conventional methods of selling duty free items and also has  
the potential to significantly increase the sale of international travel tickets. No art of which  
the applicant is aware shows any linking of the sale of international travel tickets with the sale

of duty free merchandise, thereby enabling a consumer to secure both items on a linked and discounted basis, and achieving the advantages over the prior art described in the specification.

### **Pre-Examination Search**

Pursuant to M.P.E.P. § 708.02 (VIII), the applicant has had a search performed by a professional searcher, Mr. Gregory Aharonian. Mr. Aharonian specializes in searching non-patent prior art in relation to business method and computer software patents, and has been searching in this area for over seven years. Mr. Aharonian has performed over 300 such searches.

Mr. Aharonian has a bachelors degree in Computer Science and a masters degree in Physics. He publishes an electronic newsletter relating to issues of interest to the intellectual property community, with an emphasis in computer software and business method patents.

Mr. Aharonian specializes in non-patent prior art searching, making use of university libraries on the East and West coasts (mostly those in the Boston and San Francisco areas) whose collective contents include a large volume of prior art publications.

For the subject search, Mr. Aharonian started out searching prior US patents, using the PTO's full-text patent database search system, rather than the PTO's classification system and classes, since the subject of duty-free shops could appear in a wide variety of classes. He searched the full text specifications of all patents since 1976 for any patents that contained the phrase "duty free", "dutyfree" or "duty-free" in the body of the specification or in the abstract. To date, there have been only 21 such patents, all of little or no relevance. The most relevant of these, U.S. Patent No. 5,732,398, is discussed below.

He then searched for patents with promotional and travel related aspects, and found two patents (Nos. 5,297,026 and 5,483,444) discussed below, neither of which mentions duty free shops.

Mr. Aharonian then switched to non-patent prior art, searching the ABI and INSPEC databases. ABI is for general business news, and INSPEC is for technical literature (journals and conferences). Again he made use of keyword searches for phrases such as “duty free” and “dutyfree”. He did not find much in the INSPEC database, and so relied mostly on the ABI database, which makes sense given the mostly business orientation of the instant patent application.

Copies of the 11 articles uncovered by Mr. Aharonian’s search and the three mentioned patents are attached.

The pertinence of each reference is discussed below.

### **The References**

#### **U.S. Pat. 5,297,026 (AA)**

This patent is not directly linked either to international travel or duty free shopping. The system disclosed in this patent is directed to a system for promoting activity in related financial institution accounts (such as credit cards and money market funds). In operation, this patented system provides an incentive for a user to use a single financial institution for both types of financial transactions. For example, if the user makes purchases with the institution’s credit cards, the user is accorded credits. Once the user has accumulated sufficient credits, the user may invest other funds with the institution, and thereafter receive a rate of return on the investment which is higher than that to which he would otherwise have been entitled.

The patented system does not link the sale of international travel tickets with the sale of duty free merchandise, and does not teach or suggest that these two items could be sold together in any fashion.

U.S. Pat. 5,483,444 (AB)

This patent discloses a system for awarding credits to travel agents who book travel-related reservations, and thereby offer the travel agents prizes if they secure bookings. This disclosure does not link the sale of international travel tickets and duty free merchandise and, in any event, does not provide incentives or prizes to consumers who purchase international travel tickets.

U.S. Pat. 5,732,398 (AC)

This patent discloses a self-service system for the sale of travel services. The system is intended to act like a travel agent, by querying the user as to the user's experience, likes and preferences, so as to derive a proposed travel plan for the user, without the intervention (and expense) of a human, profit-oriented, travel agent.

The system provides options of activities in which the user may engage, such as tourist sites to visit, activities and the like. One of the activities of which the user may be informed is the location of duty free shops en route. The system does not itself link the sale of international travel tickets and duty free items from a single provider, but only informs the traveler that duty free shopping may be available on an itinerary planned through the patented system. The user may be connected to the duty free shop to permit remote shopping thereat,

but the system does not link the sales of international travel tickets and duty free items by a single vendor.

#### Non-Patent Prior Art

Marketing Week, v. 18, n. 17 (July 7, 1995): 34 (AF)

This article simply notes that a duty free shop (Hoverspeed) in Dover and Folkestone (both U.K.) offered a free audio cassette to any customer who purchased a minimum of £30 of duty free items. It does not disclose linking of the sale of international travel tickets and duty free items to consumers.

#### Other Non-Patent References (AG-AO)

The remaining non-patent references merely show the state of the art of duty free shopping, as reported in the business press, and do not teach or suggest the linked sale of international travel tickets and duty free items.

#### **Detailed Discussion**

The claimed invention is directed to a method and system for the linked sale of international travel tickets and duty free merchandise. Each independent claim (1, 11, 21, 33, 43 and 54) specifically recites this combination and linkage. This combination of commercial activities is neither taught nor suggested by any of the references uncovered by the search, and renders the claims patentable.

Offering the sale of international travel tickets in combination with duty free items provides a non-obvious synergy, neither taught nor suggested in the art. By law, duty

free items may only be purchased in designated duty free areas near international travel points by consumers who can prove that they will be leaving the country.

Combining the sale of such items with the purchase of international travel tickets provides a benefit not otherwise realizable. Consumers need to travel internationally to secure duty free items, and so combining discount sales of the duty free items with the means to travel internationally offers consumers a special synergy, because the linkage of the two provides both the means to secure the items as well as the items themselves. Moreover, as explained in the specification as filed, by linking the sale of free items to the purchase of international travel tickets, the merchant is able to achieve a profit comparable or better than that attainable by conventional duty free merchants while offering the international travel tickets, duty free items or both at a price below which the consumer could otherwise acquire such items.

The uncovered references do not show any realization of this synergy, and do not teach or suggest offering for sale international travel tickets in combination with duty free items. Consequently, these references neither teach nor suggest the claimed method and system.

### Fees

The petition fee of \$130.00 as specified by 37 C.F.R. §1.17(h) is enclosed.

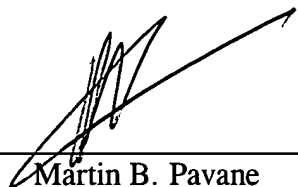
Please charge any deficiencies, or credit any overpayments to Deposit Account No. 03-2412.

A duplicate of this page is enclosed for that purpose.

Early and favorable action on this Petition is respectfully solicited.

Respectfully submitted,  
COHEN, PONTANI, LIEBERMAN & PAVANE

By



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